

### **REMARKS/ARGUMENTS**

1. The Examiner rejected claims 1, 4, 6, 13, 15, 16, and 22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and the enablement requirement. Claims 1, 3-5, 7, 10-12, 14, 15, and 17-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rohrka et al. (U.S. Patent No. 5,221,569) in view of Doyle et al. (U.S. Patent No. 4,444,822), and further in view of the teaching of the Internet site <http://na.northsails.com/Graphics/NGproducts.html>. Claims 1, 3-5, 7, 10-12, 14, 15, and 17-23 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellison (U.S. Patent No. 4,615,934) in view of the teaching of the Internet site <http://na.northsails.com/Graphics/NGproducts.html>. Claims 6, 13, and 16 were indicated as being allowable if written to overcome the rejection under 35 U.S.C. § 112, first paragraph, and to include the limitations of their base claims and any intervening claims. The specification was objected to under 37 C.F.R. § 1.75(d)(1) for failing to provide proper antecedent basis for certain subject matter recited in claims 1, 4, 6, 13, 15, 16, and 22. The drawings were objected to under 37 C.F.R. § 1.83(a) for not showing every feature of the invention specified in claims 1, 6, 13, 15, 16, and 22. Reconsideration of this application is respectfully requested in view of the amendments and remarks provided herein.

#### **Drawing Objections**

2. The drawings were objected to under 37 C.F.R. § 1.83(a) for not showing every feature of the invention specified in claims 1, 6, 13, 15, 16, and 22. In particular, the Examiner asserts that the drawings do not show (1) a sail sheet depicting informational material that remains viewably undistorted whether the sheet is in a planar orientation or an airfoil orientation as recited in claims 1, 15, and 22, and (2) a sheet that includes an opaque barrier layer disposed between the scrim and at least one of the webs of PVC as recited in claims 6, 13, and 16.

With respect to claim 22, Applicant has herein cancelled such claim. With respect to claims 1 and 15, Applicant disagrees with the Examiner's assertions. Nevertheless, to move prosecution forward, Applicant has herein amended claims 1 and 15 to delete the "viewably undistorted" limitation. With respect to claims 6, 13, and 16, Applicant submits that the original drawings (in particular, FIG. 7) depict the claimed opaque barrier layer/sheet. As clearly

illustrated in original FIG. 7, opaque barrier layer 55 is disposed on an inside surface of PVC layer 53 and between PVC layer 53 and scrim 54. Thus, original FIG. 7 shows an opaque barrier layer 55 disposed between the scrim 54 and at least one of the PVC layers 53 as previously recited in claims 6, 13, and 16 and now recited in claims 1, 15, and 21. Therefore, as a result of (a) Applicant's amendments of claims 1, 15, and 21 to incorporate the limitations of claims 6, 13, and 16, respectively, (b) the content of original FIG. 7, (c) Applicant's deletion of the "viewably undistorted" limitation from claims 1 and 15, and (d) Applicant's cancellation of claim 22, Applicant respectfully submits that the drawings comply with the requirements of 37 C.F.R. § 1.83(a) and requests that the Examiner withdraw his objection to the drawings.

### Objections to the Specification

3. The specification was objected to under 37 C.F.R. § 1.75(d)(1) for failing to provide proper antecedent basis for certain subject matter recited in claims 1, 4, 6, 13, 15, 16, and 22. In particular, the Examiner asserts that the specification does not describe (1) a sail sheet depicting informational material that remains viewably undistorted whether the sheet is in a planar orientation or an airfoil orientation as recited in claims 1, 15, and 22, (2) printing informational matter onto an outer surface of at least one of the webs of PVC vinyl as recited in claim 4, and (3) a sheet that includes an opaque barrier layer disposed between the scrim and at least one of the webs of PVC as recited in claims 6, 13, and 16.

As noted in Section 2 above, Applicant has herein cancelled claim 22 and disagrees with the Examiner's assertions. Nevertheless, to move prosecution forward, Applicant has removed the "viewably undistorted" language from claims 1 and 15. With respect to claim 4, Applicant has herein amended paragraph [0036] of the specification to include a parenthetical that states that the informational matter (as denoted by letter "L" in original FIG. 7) may be printed on an outer surface of the PVC layer as clearly illustrated in original FIG. 7. Finally, with respect to claims 6, 13, and 16, the subject matter of which has now been incorporated into claims 1, 15, and 21, respectively, Applicant has herein amended paragraph [0035] of the specification to include an express recital that the opaque barrier layer is disposed between the scrim and at least one of the PVC layers as illustrated in original FIG. 7.

Therefore, as a result of (a) Applicant's amendments of claims 1, 15, and 21 to incorporate the limitations of claims 6, 13, and 16, respectively, (b) the content of original FIG.

7, (c) Applicant's deletion of the "viewably undistorted" limitation from claims 1 and 15, (d) Applicant's cancellation of claim 22, and (e) Applicant's amendments of paragraphs [0035] and [0036] to reflect information disclosed in original FIG. 7, Applicant respectfully submits that the specification complies with the requirements of 37 C.F.R. § 1.75(d)(1) and requests that the Examiner withdraw his objection to the specification. Due to the information expressly depicted in original FIG. 7, Applicant submits that his amendments to paragraphs [0035] and [0036] of the specification do not introduce any new matter into the application.

Rejection under 35 U.S.C. § 112, first paragraph

4. Claims 1, 4, 6, 13, 15, 16, and 22 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and the enablement requirement. In particular, the Examiner asserts that the specification does not describe the following in such a way as to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention at the time the application was originally filed:

(1) a sail sheet depicting informational material that remains viewably undistorted whether the sheet is in a planar orientation or an airfoil orientation as recited in claims 1, 15, and 22;

(2) printing informational matter onto an outer surface of at least one of the webs of PVC vinyl as recited in claim 4; and

(3) a sheet that includes an opaque barrier layer disposed between the scrim and at least one of the webs of PVC as recited in claims 6, 13, and 16.

As detailed in Sections 2 and 3 above, Applicant has cancelled claim 22, removed the "viewably undistorted" language from claims 1 and 15, and amended paragraphs [0035] and [0036] of the specification to describe the opaque barrier layer/sheet and outer surface informational matter that is clearly disclosed in *original* FIG. 7. As a result, Applicant submits that claims 1, 4, 15, and 21, as presented herein, and Applicant's specification fully comply with the requirements of 35 U.S.C. § 112, first paragraph. Therefore, in view of the foregoing, Applicant respectfully requests that the Examiner withdraw his rejection of claims 1, 4, 15, and 21 (claims 1, 15, and 21 now incorporating the limitations of claims 6, 13, and 16, respectively) under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 103(a)

5. Claims 1, 3-5, 7, 10-12, 14, 15, and 17-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rohrka et al. ("Rohrka") in view of Doyle et al. ("Doyle"), and further in view of the teaching of the Internet site <http://na.northsails.com/Graphics/NGproducts.html> ("North Sails Internet Site"). Applicant disagrees with the Examiner's characterization of the present invention in view of the cited references. Nevertheless, Applicant has herein cancelled claims 22 and 23, and amended claims 1, 15, and 21 to incorporate the limitations of claims 6, 13, and 16, respectively, thereby effectively re-writing claims 6, 13, and 16 in independent form. The Examiner indicated that claims 6, 13, and 16 would be allowable if Applicant overcame the rejection of such claims under 35 U.S.C. § 112, first paragraph, and such claims were re-written in independent form to include the limitations of their base claims and any intervening claims.

Accordingly, Applicant submits that all the pending claims are in proper condition for allowance and respectfully requests that all pending claims be passed to allowance.

6. Claims 1, 3-5, 7, 10-12, 14, 15, and 17-23 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellison in view of the teaching of the North Sails Internet Site. Applicant disagrees with the Examiner's characterization of the present invention in view of the cited references. Nevertheless, Applicant has herein cancelled claims 22 and 23, and amended claims 1, 15, and 21 to incorporate the limitations of claims 6, 13, and 16, respectively, thereby effectively re-writing claims 6, 13, and 16 in independent form. The Examiner indicated that claims 6, 13, and 16 would be allowable if Applicant overcame the rejection of such claims under 35 U.S.C. § 112, first paragraph, and such claims were re-written in independent form to include the limitations of their base claims and any intervening claims.

Accordingly, Applicant submits that all the pending claims are in proper condition for allowance and respectfully requests that all pending claims be passed to allowance.

Allowed Claims

7. Applicant would like to thank the Examiner for indicating the allowability of claims 6, 13, and 16 if such claims were written to overcome the rejection under 35 U.S.C. § 112, first paragraph, and to include the limitations of their base claims and any intervening claims. Applicant submits that the limitations of claims 6, 13, and 16 were originally disclosed

in FIG. 7 of the application. Based on such disclosure, Applicant has amended paragraphs [0035] and [0036] to simply reflect the disclosure of FIG. 7 in the text of the specification. Thus, Applicant has overcome the rejection under 35 U.S.C. § 112, first paragraph, without introducing any new matter into the specification or requiring any further search or consideration by the Examiner. In addition, Applicant has incorporated the limitations of claims 6, 13, and 16, and applicable intervening claims, into claims 1, 15, and 21, respectively, thereby effectively re-writing claims 6, 13, and 16 in independent form. Thus, through its amendments to the claims and the specification, Applicant has complied with the Examiner's requirement of form expressly set forth in the Office Action in order to obtain allowable claims. See 37 C.F. R. § 1.116. As a result, Applicant submits that the application is now in proper condition for allowance and respectfully requests that the Examiner pass pending claims 1, 3-5, 7, 10-12, 14, 15, and 18-21 to allowance.

#### Other Amendments to the Claims

8. Applicant has herein amended dependent claims 10, 11 and 18 to correct their dependencies in view of the cancellation of various claims and to correct a minor informality in claim 18. Applicant submits that such amendments do not require any further search or consideration by the Examiner and do not add any new matter into the specification.

#### Summary of Interview

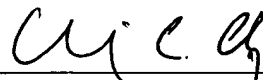
9. Applicant would like to thank the Examiner for conducting a telephonic interview with Applicant's undersigned representative on December 1-2, 2004. During the interview, Applicant's representative and the Examiner discussed the rejection of the independent claims under 35 U.S.C. § 112, first paragraph as reiterated in the Examiner's Advisory Action issued November 18, 2004 in view of the disclosure contained in Applicant's originally filed application (e.g., FIG. 7 and page 7, line 19 through page 8, line 17). As a result of the interview, the Examiner agreed that the foregoing amendments to the claims placed the application in condition for allowance.

10. The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the

Appl. No. 10/623,822  
Amdt. dated Dec. 9, 2004  
Reply to Office Action of Aug. 12, 2004

instant application. Please charge any necessary fees associated herewith (if applicable and not paid by separate check) to the undersigned's Deposit Account No. 50-1111.

Respectfully submitted,

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In re application serial no.: **10/623,822**  
File No.: **7395-03657**

**CERTIFICATE OF MAILING**

I HEREBY CERTIFY that the following correspondence: AMENDMENT AND RESPONSE UNDER 37 C.F.R. § 1.116 (11 PAGES), REQUEST FOR EXTENSION OF TIME (1 PAGE); CHECK IN AMOUNT OF \$55.00, FEE TRANSMITTAL (1 PAGE), and RETURN POSTCARD FOR CONFIRMATION OF RECEIPT is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**, this the 9<sup>th</sup> day of December, 2004.

\_\_\_\_\_  
Chriselide Mendez, Paralegal

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Date